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09/930,418	08/15/2001	Lawrence P. Bush	12016-205	1051

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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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09/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/930,418

Applicant(s)

BUSH, LAWRENCE P.

Examiner

Martin A. Gottschalk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-32 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. Claims 1-4, and 6-32 are pending. Claim 29 is currently amended. Claims 21-25 and 30-32 are withdrawn. Claim 5 is cancelled. All other claims are as previously presented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Note: The following rejections are the same as in the previous Office Action (with the exception of claim 29), and are provided here for the convenience of the reader.

Also note: Claim 29 is amended only is step (f) (as per the underlined additions) which reads

(f) analyzing said information on a card by card basis to determine trends in said usage of said cards.

This claim is rejected for the same reasons as provided in the previous Office Action. See "Response to Arguments" section below.

4. Claims 1-4, 7-20, 26, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (hereinafter APA; see specification of current application) in view of Slater (US Pat# 6,615,190, hereinafter Slater), and further in view of Rotman et al (PG Pub# US 2003/0018550, hereinafter Rotman).

A. As per claims 1, 26, and 29 APA discloses a method for administering insurance claims and monitoring claim-related data in a database, comprising the steps of:

- (a) receiving a claim (APA: pg 2, lns 2-3, reads on "...insured is required to submit a claim...");
- (b) determining a monetary value of said claim (APA: pg 2, lns 6-13; pg 3, lns 2-6).

APA fails to disclose steps c, d, and e. However, these features are well known in the art as evidenced by the teachings of Slater. Slater discloses

- (c) issuing a card representing an account;
- (d) funding with at least a portion of said monetary value (for both c and d, Slater: Fig 1, items 20-24; col 3, lns 26-30; col 7, lns 25-30; Fig 1; col 4, lns 16-18);
- (e) monitoring the activity of said account to obtain information regarding usage of said card (Slater: col 5, lns 1-11; Fig 2, item 125; col 5, lns 21-30; Fig 2, item 130).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Slater with those of APA with the motivation of avoiding both the expense and inconvenience associated with the issuance of checks to pay insurance claims (Slater: lns 10-30).

Note: The motivation to combine the teachings of APA and Slater for claims following in this section is the same as provided for claims 1, 26, and 29 above.

The combined teachings of APA and Slater fail to explicitly disclose step 1(f), however this feature is well known in the art as evidenced by the teachings of Rotman who teaches

- (f) analyzing said information to determine trends in said usage of said card (Rotman: [0024]; [0080]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Rotman with the collective disclosure of APA and Slater with the motivation of using purchase data to demonstrate industry-wide trends (e.g. automotive related industries) in near real-time (Rotman: [0021] – [0023]).

Note: The motivation to combine the teachings of APA, Slater, and Rotman for claims following in this section is the same as provided for claims 1, 26, and 29 above.

B. As per claim 2, Rotman discloses the method according to claim 1, wherein said trends comprise purchase trends (Rotman: [0054]-[0056]).

C. As per claims 3 and 27 (h), Slater discloses the method according to claim 1, further comprising the step of:

- (g) analyzing said information to determine the accuracy of said determining said

monetary value (Slater: col 6, Ins 7-12, reads on cardholder may check the balance.).

D. As per claim 4, Slater discloses the method according to claim 1 wherein said card account is

a debit card account (Slater: col 2, Ins 19-26; col 3, Ins 26-35. The Examiner considers a card issued to an individual, associated with an account that is funded by a known amount, which limits the amount of purchases that can be made with the card by limiting the purchases to debits of the account as opposed to an extension of credit, to be a form of debit card.).

E. As per claim 7, APA discloses the method according to claim 1, wherein said claim relates to

an automobile accident (APA: pg 2, Ins 1-3; pg 3, Ins 1-5).

F. As per claims 8 and 9, Slater discloses the method according to claim 1, wherein said claim relates to

(claim 8) medical treatment.

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and

(claim 9) death benefits (pertains to both the recitations of claims 8 and 9, Slater: col 7, lns 15-25, note that social security benefits claims include both medical treatment and death benefits.).

G. As per claim 10, APA discloses the method according to claim 1, wherein said claim relates to

property damage (APA: pg 2, lns 1-3; pg 3, lns 1-5. The Examiner considers an automobile accident to be a form of property damage).

H. As per claim 11, APA discloses the method according to claim 1, wherein said claim relates to

property loss (APA: pg 2, lns 1-3; pg 3, lns 1-5. The Examiner considers an automobile accident to be a form of property loss).

I. As per claim 12, APA discloses the method according to claim 1, wherein said claim relates to

theft (Slater: col 7, Ins 25-30, note that theft insurance is a common type of insurance).

J. As per claims 13-16, Slater discloses the method according to claim 1, wherein the information obtained in step (e) includes

(claim 13) a time of usage of said card.

(claim 14) a monetary amount related to said usage of said card.

(claim 15) a place of usage of said card.

(claim 16) a time, place, and amount

of each occurrence of usage of said card (pertains to claims 13-16, Slater: col 2, Ins 42-49; col 5, Ins 3-11, note the disclosed maintenance of records for all account transactions, and the generation of a report listing the transactions. The Examiner considers such listings to include the time, place, and amount of the transactions including purchases).

K. As per claim 17, Slater discloses the method according to claim 1, further comprising the step of:

(g) closing said account after a predetermined amount of time (Slater: col 4, Ins 37-39; Fig 1, item 36).

L As per claim 18, Slater discloses the method of claim 17, further comprising the step of:

before step (g), disbursing any balance remaining in said account (Slater: col 4, 64-66, note that the sponsor can remove and an employee can withdraw funds. The Examiner considers reducing funds from the account to zero prior to closing the account to be a form of disbursing remaining funds. See also col 5, ln 65 to col 6, ln 15, noting that the cardholder can transfer remaining balances to another account prior to account closure.).

M. As per claim 19, Slater discloses the method of claim 1 wherein said card account is managed by a

third party claim service provider (Slater: col 3, Ins 48-50, reads on "...credit network...").

N. As per claim 20, Slater discloses the method of claim 1 wherein said card account is managed by an

insurance company (Slater: col 2, lns 22-25; note the disclosure that a financial institution can be an issuer, that the Examiner considers an insurance company to be a type of financial institution. Note also that an insurance company can also be a sponsor, col 25-27, and further note that the sponsor is responsible for determining whether or not funds should be added to the account, which the Examiner considers to be a form of management.).

O. As per claims 27(f), and 27(g), Rotman teaches

(claims 27(f)) analyzing the collated data; and

(claims 27(g)) identifying statistically significant trends in the
purchase information (Rotman: [0024]).

5. Claims 6 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA, Slater, and Rotman as applied to claim 1 above, and further in view of Cherrington et al (US Pat# 5,717,595, hereinafter Cherrington).

A. As per claims 6, Slater teaches the method according to claim 1

wherein said usage of said card reflects the payment of an insurance claim
(Slater: col 7, lns 25-31).

The combined teachings of APA, Slater, and Rotman fail to disclose the remaining features of the claim, however, these features are well known in the art as evidenced by the teachings of Cherrington who teaches the method according to claim 1 wherein the insurance claim refers specifically to a vehicle repair

and further comprising the step of:

(g) comparing said determined monetary value of said claim to said actual repair cost of said vehicle (Cherrington: Fig 10, item 1012, col 20, lns 47-67).

It would have been obvious at the time of the invention to modify the combined teachings of APA, Slater, and Rotman to verify that the actual invoice cost of a vehicle repair does not exceed the estimated cost by more than the legally allowed amount (Cherrington: col 2, lns 51-57). The same motivation applies to claim 28 below.

B. As per claim 28, the combined teachings of APA, Slater, and Rotman fail to disclose the features of the claim, however, they are well known in the art as evidenced

by the teachings of Cherrington who teaches the method according to claim 27, further comprising the step of:

- (i) modifying said determining said monetary value in response to said evaluated accuracy of said monetary value determination (Cherrington: Fig 10, item 1008-1010, col 20, lns 47-67).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 26, and 29 (step f in each claim) have been considered but are not considered to be persuasive. Applicant argues that the Rotman teaches away from the claimed feature of (e.g. as in claim 29)

analyzing said information on a card by card basis to determine trends in said usage of said cards

because the Rotman reference is directed towards analysis of aggregated card data and not individual data.

In response, the Examiner notes that Rotman discloses that cardholder individual demographic information (Rotman: [0011] and [0013]), though cardholders are offered the option of removing their names from mailing lists if they object to this practice. Rotman does note however that individual **purchase** data from individuals is more

controversial to use than demographic data (Roman: [0014]), however, Rothman does not imply that individual information could not be used, or would not be useful, only that consumers might object, and that issuers frequently adopt policies against the practice to allay such consumer concerns. The Examiner maintains that the analytical processes taught by Rothman could easily be adapted by one of ordinary skill in the art to individual cardholder data should a company make the policy choice to do so. The motivation to do so is as provided above in the rejection of the claims. See *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30 2007).

Conclusion

7. This is a continuation of applicant's earlier Application No. 09/930. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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08/30/2007



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PRIMARY EXAMINER